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10/773,548	02/06/2004	Marc Vollenweider	EVS-001	6479

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5 and 17-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 17-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

DETAILED ACTION

Election/Restrictions

1.   Applicant's **election** with traverse of **Claims 1-5 and 17-21** in the reply filed on 11/30/2007 is **acknowledged**.

The traversal is on the ground(s) that the two inventions are classified in the same class and sub-class. This is not found persuasive because despite being in the same class, inventions are different requiring different searches. The requirement is still deemed proper and is therefore election made **FINAL**. As such **claims 1-5 and 17-21** are pending.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   **Claim1-5 and 17-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Thomas*** et al (6,832,211) in view of ***Breitzman*** et al (6,175,824).

As per claim 1, *Thomas* discloses a method of estimating the relative impact of two or more patent portfolios of one or more companies, each patent portfolio of each company comprising patents belonging to at least one market segment, the market segment having a market size and a market growth rate, each company having a market share in one or more market segments (see **Abstract and Fig.2**), the method comprising the steps of:

a. categorizing a patent of the patent portfolio of a company into at least one market segment (see **Fig.2**; via a company 3COM Corp. and its market segment computers);

b. computing a Technological Strength Index (TSI) value for the patent, the TSI value of the patent being computed based on the number of forward and backward references of the patent (see **Fig.2** and col.4, lines 23-27; via CII, a measure of company's patents are cited in recent years relative to all US patents).

c. computing an Economic Impact Index (EII) value for the patent, the EII value being computed based on at least one parameter from a set of parameters including market size of each market segment into which the patent is categorized, market growth rate of each market segment into which the patent is categorized, and market share of the company in each market segment into which the patent is categorized (see **Fig.2**; via computer patent percentage growth and inherent size and share as implied) ;

d. repeating steps a to c for each patent in the patent portfolio of the company (**Fig.2**);

e. computing a Company Innovation Efficiency Index (CIEI) value for the patent portfolio of the company, the efficiency impact value being computed based on Research and Development (R&D) expenditure of the company and number of patents in the patent portfolio of the company (see **Fig.2**; via **R&D** intensity and **Col.6**, line 61-63, higher market-to-book **[MTB]** valuation),

f. repeating steps a to e for each company (**Fig.2** and **R&D**; and **MTB**);

Thomas fails to disclose explicitly the step of computing an Overall Index value for each patent portfolio, the Overall Index value being computed using at least one parameter from a set of parameters including the TSI values for all patents in the patent portfolio of the company, the EII values for all patents in the patent portfolio of the company, and the CIEI value for the patent portfolio of the company, whereby the Overall Index values for portfolios indicate the relative impact of their respective patent portfolios.

However, *Breitzman* being in the same field of invention discloses the step of computing an Overall Index value for each patent portfolio, the Overall Index value being computed using at least one parameter from a set of parameters including the TSI values for all patents in the patent portfolio of the company, the EII values for all patents in the patent portfolio of the company, and the CIEI value for the patent portfolio of the company, whereby the Overall Index values for portfolios indicate the relative impact of their respective patent portfolios (see **Fig.2 [1 of 2]**, via Current impact index of 5.61 for 3COM Corp. and **col.6**, line 23-44).

Therefore, it would have been obvious to one of ordinary skill n the art at the time invention was made to modify the disclosure of **Thomas** and to include the above feature as disclosed by Breitzman, to derive relative Impect index of portfolios

As per the claim 2, **Thomas** discloses the step of computing the TSI value for the patent further comprises the steps of:

a. computing a normalized value for the number of backward references of the patent, the normalization being done based on the numbers of backward references of all patents in the patent portfolios of all companies; b. computing a normalized value for the number of forward references of the patent, the normalization being done based on the numbers of forward references of all patents in the patent portfolios of all companies; and c. computing the TSI value for the patent using the normalized value for the number of forward references and the number of backward references (see **col.4**, lines 23-36; via backward-forward citations and normalized values to have current Indict index).

As per claim 3, **Thomas** discloses the step of computing the normalized value for the number of backward references of the patent further comprises the steps of:

a. determining the maximum value of backward references among the number of backward references for all patents in the patent portfolios of all companies; and b. normalizing the value for the number of backward references of the patent by dividing it by the determined maximum value of backward references (see **col.4**, lines 23-36 via backward citation and as implied with normalized values).

As per claim 4, *Thomas* discloses further the computing the normalized value

for the number of forward references of the patent further comprises the steps of:

a. determining the maximum value of forward references among the number of

forward references for all patents in the patent portfolios of all companies; and b.

normalizing the value for the number of forward references of the patent by dividing it by

the determined maximum value of forward references(see col.4, lines 38-52; via a

company that cites a large number of recent patens {forward citation] is likely to be

innovating rapidly and could be calculated normalized values)

As per the claim 5, Thomas discloses the step of computing the Economic

Impact Index (EII) value for the patent further comprises the steps of:

a. computing a normalized value for market size of each market segment into

which the patent is categorized, the normalization being done based on market sizes of

all market segments, to which any patent of any patent portfolio belongs (**Fig.2**; via

categorized and normalized patents) ;

b. computing a normalized value for market growth rate of each market segment

into which the patent is categorized, the normalization being done based on market

growth rates of all market segments, to which any patent of any patent portfolio

belongs(**Fig.2**, col.4,via growth percentage);

c. computing a normalized value for market share of the company in each market

segment into which the patent is categorized, the normalization of the market share of

the company in a market segment being done based on the market shares of all companies in the market segment (**Fig.2** ; via patent growth on computers segment of 3COM Corp.); and

d. computing the EII value for the patent using at least one parameter from the set of parameters including the normalized value for market size of each market seamen into which the patent is categorized, the .normalized. value for market growth rate of each market segment into which the patent is categorized, and the normalized value of the market share of the company in each market segment into which the patent is categorized (**Fig.2**; via patent on computer categories and calculated normalized values).

As per claim 17, *Thomas*, disclose a computer program product for estimating the relative impact of two or more patent portfolios of one or more companies, the patent portfolio of each company comprising patents belonging to at least one market segment, the market segment having a market size and a market growth rate, each company having a market share in one or more market segments (**Fig.2**; via 3COM Corp , AT&T and other companies of different industries listed with information in columns), the computer program product comprising:

a. program instruction means for categorizing each patent of the patent portfolio of a company into at least one market segment (see **Fig.2**; via a company 3COM Corp. and its market segment computers);

b. program instruction means for computing a Technological Strength Index (TSI) value for each patent of the patent portfolio of the company, the TSI value of the patent

being computed based on the number of forward and backward references of the patent (see **Fig.2** and col.4, lines 23-27; via CII, a measure of company's patents are cited in recent years relative to all US patents).

c. program instruction means for computing an Economic Impact Index (EII) value for each patent, the EII value being computed based on at least one parameter from a set of parameters including market size of each market segment into 20 which the patent is categorized, a market growth rate of each market segment into which the patent is categorized, and a market share of the company in each market segment into which the patent is categorized (see **Fig.2**; via computer patent percentage growth and inherent size and share as implied);

d. program instruction means for computing a value for Company Innovation Efficiency Index (CIEI) value of the patent portfolio of the company, the CIEI value being computed based on Research and Development (R&D) expenditure of the company and number of patents in the patent portfolio of the company (see **Fig.2**; via **R&D** intensity and **Col.6**, line 61-63, higher market-to-book [**MTB**] valuation).

Thomas fails to disclose explicitly the step of computing an Overall Index value for each patent portfolio, the Overall Index value being computed using at least one parameter from a set of parameters including the TSI values for all patents in the patent portfolio of the company, the EII values for all patents in the patent portfolio of the company, and the CIEI value for the patent portfolio of the company, whereby the Overall Index values for portfolios indicate the relative impact of their respective patent portfolios.

However, **Breitzman** being in the same field of invention discloses the step of computing an Overall Index value for each patent portfolio, the Overall Index value being computed using at least one parameter from a set of parameters including the TSI values for all patents in the patent portfolio of the company, the EII values for all patents in the patent portfolio of the company, and the CIEI value for the patent portfolio of the company, whereby the Overall Index values for portfolios indicate the relative impact of their respective patent portfolios (see **Fig.2 [1 of 2]**, via Current impact index of 5.61 for 3COM Corp. and **col.6**, line 23-44).

Therefore, it would have been obvious to one of ordinary skill n the art at the time invention was made to modify the disclosure of **Thomas** and to include the feature of index value as taught by **Breitzman** to facilitate in order to derive relative Impact index of portfolio)

Claims 18-21 are rejected as per the reasons set forth in **claims 2-5** respectively

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Elliot (7,269,566) discloses method for obtaining and allocating Investment Income Based on the capitalization of Intellectual property.

Barney et al (6,556,992) discloses method and system for Rating Patents and Other Intangible Assets.

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohamed H. Ali whose telephone number is 571-270-3021. The examiner can normally be reached on 8.00 to 6.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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